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D OFC-2248.1.2

EXAMINER

KENEALY, D

33M1/1027

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915 OLIVE STREET  
STE. 1017  
ST. LOUIS, MO 63101

ART UNIT

PAPER NUMBER

3301

4

DATE MAILED:

10/27/93

This is a communication from the examiner in charge of your application.  
COMMISSIONER OF PATENTS AND TRADEMARKS

This application has been examined

Responsive to communication filed on 7/1/93  This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s),        days from the date of this letter.  
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

1.  Notice of References Cited by Examiner, PTO-892.
2.  Notice re Patent Drawing, PTO-948.
3.  Notice of Art Cited by Applicant, PTO-1449.
4.  Notice of Informal Patent Application, Form PTO-152.
5.  Information on How to Effect Drawing Changes, PTO-1474.
6.  \_\_\_\_\_

Part II SUMMARY OF ACTION

1.  Claims 1-22 are pending in the application.

Of the above, claims \_\_\_\_\_ are withdrawn from consideration.

2.  Claims \_\_\_\_\_ have been cancelled.

3.  Claims \_\_\_\_\_ are allowed.

4.  Claims 1-22 are rejected.

5.  Claims \_\_\_\_\_ are objected to.

6.  Claims \_\_\_\_\_ are subject to restriction or election requirement.

7.  This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.

8.  Formal drawings are required in response to this Office action.

9.  The corrected or substitute drawings have been received on \_\_\_\_\_. Under 37 C.F.R. 1.84 these drawings are  acceptable.  not acceptable (see explanation or Notice re Patent Drawing, PTO-948).

10.  The proposed additional or substitute sheet(s) of drawings, filed on \_\_\_\_\_ has (have) been  approved by the examiner.  disapproved by the examiner (see explanation).

11.  The proposed drawing correction, filed on \_\_\_\_\_, has been  approved.  disapproved (see explanation).

12.  Acknowledgment is made of the claim for priority under U.S.C. 119. The certified copy has  been received  not been received  been filed in parent application, serial no. \_\_\_\_\_; filed on \_\_\_\_\_

13.  Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.

14.  Other

EXAMINER'S ACTION

The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --  
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1,4,6,8,9 and 12 are rejected under 35 U.S.C. § 102(b) as being anticipated by Totaro for the reasons stated in the previous Office Action of 4/29/93.

The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Claims 2,3,5,10,11,14,15 and 17-21 are rejected under 35 U.S.C. § 103 as being unpatentable over Rubin in view of Totaro for the reasons as set forth in the 4/29/93 Office Action.

Claim 16 is rejected under 35 U.S.C. § 103 as being unpatentable over Rubin in view of Totaro and further in view of Kvare for the reasons set forth in the 4/29/93 Office Action.

Claims 7 and 13 are rejected under 35 U.S.C. § 103 as being unpatentable over Totaro in view of Favary for the reasons set forth in the 4/29/93 Office Action.

Claim 11 is rejected under 35 U.S.C. § 103 as being unpatentable over Totaro in view of Forbes for the reasons set forth in the 4/29/93 Office Action.

Claim 19 is rejected under 35 U.S.C. § 103 as being unpatentable over Rubin in view of Totaro and further in view of Forbes for the reasons set forth in the 4/29/93 Office Action.

Claim 22 is rejected under 35 U.S.C. § 103 as being unpatentable over Totaro in view of Shanel. The use of plastic as a material for the frame is considered obvious in the art of shields as shown by the Shanel reference's plastic support frame.

RESPONSE TO APPLICANT'S REMARKS

Totaro may disclose a device that is intended to be used for purposes other than the purposes disclosed for applicant's invention, but it is still believed that Totaro discloses all structure being claimed by applicant in the claims rejected under 35 USC 102 (b).

In the Totaro disclosure, column 3 lines 30-40, the device is described as a "U-shaped frame formed of a flexible metal or iron rod 5 which passes through conduits 1 and 2 to form a flexible frame structure for supporting an integral rubber sheet 6 on three sides." Totaro further describes the invention as an "integral

sheet and frame structure". This language is considered to disclose - a flexible impervious membrane mounted on a support device that has an elongate handle extending therefrom - as required in applicant's claim 1. Examiner is not persuaded by applicant's argument that Totaro only discloses a flexible membrane that is not supported by a frame structure and is simply placed on a user's mouth prior to placing a frame on top of the membrane. It is argued that Totaro also contemplated his invention as optionally having the support mechanism integrally built into the flexible membrane - see the description of Figure 2 column 3 line 13 where Totaro contemplates the elastic frame either being **supported or carried** by the aspirating structure. Examiner relies on this disclosure as well as the physical description of the detailed embodiment of the invention for a disclosure of the structure that anticipates applicant's claims.

In the alternative, where Totaro's embodiment comprises a flexible sheet that is not joined integrally with the frame mechanism, it is argued that applicant's claims are still anticipated. The only relevant limitation that applicant sets forth in claim 1 is the requirement that the membrane be "mounted upon a supporting device". This limitation is anticipated by either embodiment of the Totaro reference since it does not require the membrane to be secured to or integral with any portion of the frame.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the

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extension of time policy as set forth in 37 C.F.R. § 1.136(a).

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Kenealy whose telephone number is (703) 308-2680.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0858.

DJK  
DJK  
October 12, 1993

  
ROBERT A. HAFER  
S.P.E.  
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